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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR        | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------------|---------------------|------------------|
| 10/777,953  | 02/12/2004  | Steve Johnson               | 8M30.1-020          | 5353             |
| 23506 7590 05/18/2009<br>GARDNER GROFF GREENWALD & VILLANUEVA, PC<br>2018 POWERS FERRY ROAD<br>SUITE 800<br>ATLANTA, GA 30339 |             |                             |                     |                  |
| EXAMINER<br>DICUS, TAMRA  |             |                             |                     |                  |
| ART UNIT<br>1794  |             | PAPER NUMBER                |                     |                  |
| NOTIFICATION DATE<br>05/18/2009   |             | DELIVERY MODE<br>ELECTRONIC |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@gardnergroff.com  
mkandcer@gardnergroff.com

### Office Action Summary

**Application No.**

10/777,953

**Applicant(s)**

JOHNSON, STEVE

**Examiner**

TAMRA L. DICUS

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03/24/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The prior rejections are withdrawn due to Applicant's amendments.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites a mosaic arrangement, however, the claims do not have the proper support in the original specification as filed because the specification does not provide any teaching or discussion on a mosaic arrangement or its usage with Applicant's claimed article and thus said term(s) is considered new matter. See for instance pages 11-13 to a camouflage pattern and method of making it, but no mentioning of a mosaic form.

***Claim Rejections - 35 USC § 102***

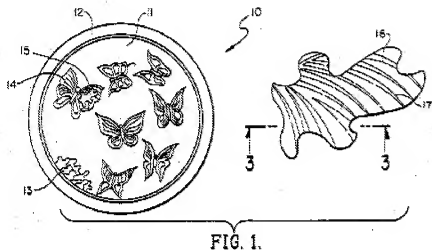
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by USPN 4,816,302 to Shaw.

Shaw illustrates a camouflage pattern comprising a plurality of images exclusively of wings of a flying insect (14, FIG. 1 and associated text, 3:1-5), in this case a butterfly and in a mosaic pattern (1:15-25, 1:50-55, 2:68) forming a camouflage pattern on an article such as a decorative article. See Fig. 1 below. Claim 1 is met.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,816,302 to Shaw in view of US 6,342,290 to Konk.

Shaw teaches the claimed invention above.

Shaw does not teach plants (claim 5).

Shaw teaches a plurality of butterfly images in a mosaic or matrix graphic pattern, and another image (generally of a painting, or printing, or

pictorial, 3:54-55, 4:1-55) to fit or be arranged next to the butterfly image for an illusion.

Conk teaches patterns for camouflage taken with a photograph of any environment and its' landscape including marsh environments and images of plants (bushes). See Abstract, col. 2, col. 4. Conk also teaches that it is known that camouflage prevents people from being detected by other people and animals (1:15-16), and that a good camouflage allows hunters to avoid startling wildlife (1:16-17). Conk teaches his pattern for camouflage includes taking photographs and selecting photographic images that represent or simulate the landscape features in the selected environment which realistically blends the images for camouflage patterns. Such a landscape implied would be a landscape of a flying insects that exist in nature such as the marsh environment taught by Conk. See 2:30-68, 4:40-60, 5:3.

Because Conk teaches any environment can be recreated by taking photographs of landscapes and that it is known that camouflage is known for preventing detection of animals, it would have been obvious to one having ordinary skill in the art to modify the image of Shaw and add images plants to the decorative article of Shaw in order to simulate a natural environment and blend well with an insect infested environment as taught by Conk (see citing above). Further images shapes are optimizable. It has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284. Size of an article ordinarily is not a matter of

invention. The size recitations are all deemed matters of choice involving differences in degree and/or size and are not patentable distinctions. In re Rose, 105 USPQ 237. It has been held that mere printed matter having no new or unobvious functional relationship between the printed matter and the substrate is unpatentable. See *In re Gulack*, 703 F.2d 1381, 217 U.S.P.Q. 401 (Fed. Cir. 1983). The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See *In re Seid* 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Thus, given that the prior art accounts for various patterns, the shape or inclusion of different image shapes instantly claimed are obvious and optimizable for providing decoration to the sheet absent unexpected results or criticality.

### ***Response to Arguments***

Applicant's arguments reply on 03/24/08 are fully considered but are not convincing in view of the new grounds of rejection.

In accordance with MPEP 714 and 2163.06 no amendment may introduce new matter and Applicant should specifically point out support for any amendment made to the disclosure.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax



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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/  
Supervisory Patent Examiner, Art Unit 1794

Tamra L. Dicus /TLD/  
Examiner  
Art Unit 1794

May 12, 2008